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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,230	03/19/2002	Kazuo Hiraguchi	Q69036	1692

7590 09/08/2004

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EXAMINER	
HAUGLAND, SCOTT J	

ART UNIT	PAPER NUMBER
3654	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/088,230	Applicant(s) HIRAGUCHI ET AL.	
	Examiner Scott Haugland	Art Unit 3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-13 and 15-25* is/are pending in the application.

4a) Of the above claim(s) *15 and 16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-13 and 17-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 15 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/17/03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-13 and 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of the claims are not clear since it is not clear if a single cassette or a collection of cassettes is claimed and, if a collection is claimed, how the cassettes of that collection are physically, structurally, or cooperatively related. E.g., would a cassette having the claimed dimensions relative to an existing cassette meet the claims?

It is not clearly set forth in the claims that the first cassette recited in claim 17, line 11, claim 23, line 13, claim 24, line 12, and claim 25, line 12 and the additional cassette recited in claim 17, lines 11-12, claim 23, line 13, claim 24, lines 12-13, and

claim 25, lines 12-13 are ones of the magnetic tape cassettes recited in claim 17, line 1, claim 23, line 1, claim 24, line 1, or claim 25, line 1.

There is no claimed cooperation or structural relationship between the positioning marks recited in claim 18, line 5, claim 19, line 5, claim 23, line 16, claim 24, line 14 and any of the cassettes or any other recited structure. The claims do not indicate whether they are part of a cassette, a recording device, or some other unrecited structure.

In claim 19, lines 2-3, "the tape running openings" lacks antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6, 9, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of page 1, line 7 - page 7, line 19 of the specification and Figs. 10-12.

The admitted prior art discloses magnetic tape cassettes adapted to be operated in a recording and reproducing apparatus that can operate cassettes of different sizes (p. 3, line 15 - p. 4, line 15) including L, M, and S cassettes (page 4, lines 4-15) comprising (a) magnetic tape, (b) tape reels 70, 80 having upper flanges 71, 81, lower flanges 72, 82, and bosses 73, 83, (c) an upper cassette half 51, (d) a lower cassette

half 52 having ribs 59a, 59b formed at the front end of the lower half, (e) tape running openings 57a, 57b, (f) guide members 58a, 58b, and (g) positioning marks (positioning holes) 90a, 90b. The distance between positioning marks 90a, 90b are the same in cassettes of different sizes (p. 6, lines 16-21). The cassettes have the same vertical length and varying horizontal lengths (p. 3, lines 15-18).

The admitted prior art does not disclose that the difference between the height of a radially inner portion of the lower flanges and the height of the ribs is the same for all of the cassettes.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the difference between the height of the radially inner portion of the flanges of one cassette and the height of the ribs the same as another of the cassettes to provide the same clearance between the tape and ribs and to locate the tape in the same position in the recording and reproducing apparatus no matter what size the cassette is or to allow its use in a different recording and reproducing apparatus.

Claims 7, 8, 10-13, 18, 19, and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of page 1, line 7 - page 7, line 19 of the specification and Figs. 10-12 as applied to claim 6 above, and further in view of Ota et al (Japanese document No. 5-347079).

The admitted prior art does not disclose that the distance between guide members 58a, 58b varies among the tape cassettes, that inclinations defined by

connecting the bosses and guide members are the same in all of the cassettes, or that the widths of tape running openings are the same in the cassettes.

Ota et al teaches making the distance between guide members 5, 5, 27, 27 different on cassettes of different sizes (Figs. 13, 15) adapted to be used in the same recording and reproducing apparatus. The inclinations defined by connecting the bosses and the guide members appear to be similar in cassettes of different sizes (Figs. 13, 15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the distances between guide members in cassettes of different sizes different as taught by Ota et al and to make the inclinations of the tape running paths the same to provide similar tape feeding tension characteristics for the cassettes since Ota et al teaches that the tape need not exit cassettes of different sizes at the same points relative to a tape recording and reproducing apparatus in order for the cassettes to be used in the same tape recording and reproducing apparatus. It would have been obvious to make the widths of the tape running openings the same on cassettes of different sizes since the same size of tape is used in all of them and would not require different sizes of access openings.

Response to Arguments

Applicants' arguments filed 12/17/03 have been fully considered but they are not persuasive.

Applicants argue, with regard to the 35 U.S.C. 112, second paragraph rejection that the claims specify a structural relation between the cassettes. However, the claims do not specify how the cassettes of the invention cooperate with one another or how they are physically or structurally related in operation. Applicants claim two or more separate unconnected devices (cassettes) that are not intended to be used together. Specifying relative dimensions or a similar intended use does not establish cooperation between the cassettes. This is just defining the dimensions of one in terms of another, but does not make one dependent upon the other for operation. If there is no cooperation between the cassettes in a claim, then the claim is directed to multiple inventions recited in a single claim and not to a single invention.

Applicants argue that the admitted prior art does not mention locating the tape in the same position in the recording and reproducing apparatus regardless of the size of the cassette. However, the prior art teaches that a tape clearance resulting from a certain difference between the height of the flanges and the height of the ribs is acceptable in one cassette. It would have been obvious to one having ordinary skill in the art that the same clearance would have been acceptable on cassettes having other sizes. Selection of cartridge dimensions would have been well within the level of skill of an ordinary artisan and it would have been clear to an ordinary artisan that wide ranges of dimensions could be used to form operable cassettes. The limitation in the claims that the cassettes are adapted to be used in a recording and reproducing apparatus, is met by any set of cassettes, since that set of cassettes would be adapted to be used in a recording and reproducing apparatus designed to handle all cassettes of that set.

Applicants argue that no support has been cited in Ota et al for the conclusions of obviousness. However, as pointed out in the rejection, Ota et al teaches providing different guide member spacings in cassettes of different sizes and teaches providing similar tape inclinations (defined by lines connecting the bosses and the guide members) in cassettes of different sizes. Ota et al also teaches
teaches that the tape need not exit cassettes of different sizes at the same points relative to a tape recording and reproducing apparatus in order for the cassettes to be used in the same tape recording and reproducing. It would be obvious from Ota et al, if not from basic knowledge of the art alone, to form two cassettes with the recited relative dimensions since the range of usable dimensions for forming cassettes is well known to be large.

Applicants argue that the Examiner appeared to be comparing the width of the tape openings to the height of the tape. This was not the intent. The relevant claims refer to the width of the tape openings in the horizontal direction. The rejection refers to the size of the tape. All of the cartridges deal with the same size of tape (height and thickness). It would have been clear to an ordinary artisan that an opening of a size used in one of the cassette would produce an operable cassette when used in another cassette, especially when the same tape is used in both cassettes, thus resulting in the same relationships between the tape dimensions and flexibility and opening dimensions. In any case, it would an ordinary artisan would appreciate that a wide range of dimensions would be capable of providing an operable cassette.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Haugland whose telephone number is (703) 305-6498. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (703) 308-2688. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SJH
sjh
8/31/04

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